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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,563	09/28/2001	Masaaki Nishikiori	1086.1139CIP	2578
21171	7590	12/12/2007	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			WINTER, JOHN M	
		ART UNIT	PAPER NUMBER	
		3621		
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		12/12/2007		PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/964,563	NISHIKIORI ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	John M. Winter	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 October 2007.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.  
 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-13 and 17 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.<br><br>   | 6) <input type="checkbox"/> Other: _____.                         |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13, and 17 are drawn towards electronic negotiation, classified in class 705 subclass 51.

Claims 14-16 is drawn is drawn towards trading matching or bidding, classified in class 705 subclass 51.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed in invention I does not require the particulars of the subcombination as claimed in inventions II such as a bid.

Examiner notes that it would be a burden to search multiple inventions given their separate status in the art as noted above.

The requirement is deemed proper and therefore made FINAL.

Via paper filed on October 4,2007 a provisional election was made without traverse to prosecute the of Invention I, claims1-13 and 17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

**Status**

Claims 1-13 and 17 remain pending.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloo (US Patent 5,895,450) in view of Burchetta et al. (US Patent 6,330,551) and Further in view of Reese (US Patent 6,236,980).

As per claim 1,

Sloo ('450) discloses a mediation negotiating method for mediating a negotiation between a client and providers of goods and/or services using a electronic network, comprising: forming requesting conditions including a plurality of conditional items in which priorities have been allocated to request purchase information in response to a mediating request of said client received via the network, (Column 7, lines 66-67; column 8 lines 1-4 – Establishing

a settlement, conditions of acceptance.[examiner submits that “purchase information” is well known in field of dispute resolution, usually the subject of the dispute])

herein the forming of the requesting conditions comprises analyzing the mediating request from the client to form said plurality of items, and said plurality of items includes items formed from an inquiry to the client, items formed from client information, items calculated from values of already established request items, or a combination thereof; (column 4, lines 61-67. )

forming a negotiation field; (column 4, lines 61-67

inputting said requesting conditions; notifying, via the network, the requesting conditions to a plurality of providers selected in accordance with said requesting conditions; receiving, via the network, response information from the plurality of providers who participate in said negotiation field; and notifying, via the network, said client and the selected providers of the response information of all of the participating providers (Column 8, lines 33-58; figure 7 – steps 718-724)

Sloo ('450) does not explicitly disclose “selected in accordance with the priorities of said request purchase informations”, Reese ('980) discloses “selected in accordance with the priorities of said request purchase informations”. (Figures 6 [item 156 ranking by stars ] and 16 [356 ranking indicator] ). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Reese ('980) method in order in order to improve the percentage of negations that are settled.

Claims 3, 12 ,13 and 17 are in parallel with claim 1 and are rejected for at least the same reasons.

As per claim 2,

Sloo ('450) discloses a method according to claim 1 wherein in said forming of requesting conditions to request articles or the request purchase informations such as service, price, term of delivery, and the like, thereby forming the requesting purchase information as said requesting conditions.(Column 7, lines 66-67; column 8 lines 1-4; figure 3).

As per claim 4

Sloo ('450) discloses a method according to claim 1

Sloo ('450) does not explicitly disclose “an abstract mediating request from the client is analyzed and one or a plurality of requesting conditions are formed”, Burchetta et al. ('551) discloses “ an abstract mediating request from the client is analyzed and one or a plurality of requesting conditions are formed”.(Column 7, lines 26-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Burchetta et al. ('551) method in order in order to improve the percentage of negotiations that are settled.

As per claim 5,

Sloo ('450) discloses a method according to claim 1

Sloo ('450) does not explicitly disclose “ the request purchase information priorities in the requesting conditions inputted into said negotiation field are changed and inputted again”, Burchetta et al. ('551) discloses “ the request purchase information including the priorities in the requesting conditions inputted into said negotiation field are changed and inputted again”.(Figure 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Burchetta et al. ('551) method in order in order to improve the percentage of negations that are settled.

As per claim 6,

Sloo ('450) discloses a method according to claim 1

Wherein in said negotiation requesting step, if there are a plurality of requesting conditions, the responder is selected under a condition that he corresponds to at least one of said plurality of requesting conditions, and the negotiation field between said client is formed.(Column 8, lines 5-19).

As per claim 7,

Sloo ('450) discloses a method according to claim 1

Wherein In said negotiation requesting step, a negotiation term is set into said negotiation field and the requesting conditions are inputted,(Figure 3) and in said negotiation responding step, the end of the negotiation is discriminated and the negotiation field is closed.(Figure 7).

As per claim 8,

Sloo ('450) discloses a method according to claim 7 wherein in said negotiation responding step, the negotiation field is closed by a negotiation decision instruction of said client or an expiration of the negotiation term.(Column 8, lines 44-58).

As per claim 9,

Sloo ('450) discloses a method according to claim 7 Sloo ('450) does not explicitly disclose “the negotiation term is extended on the basis of an instruction from the client”, Burchetta et al. ('551) discloses “the negotiation term is extended on the basis of an instruction from the client”.(Column 8, lines 40-52). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Burchetta et al. ('551) method in order in order to improve the percentage of negations that are settled.

As per claim 10,

Sloo ('450) discloses a method according to claim 7 Sloo ('450) does not explicitly disclose “when conditions which negotiation responding step, have been preset are satisfied upon expiration of the negotiation term, the negotiation term is automatically extended”, Burchetta et al. ('551) discloses “when conditions which negotiation responding step, have been preset are satisfied upon expiration of the negotiation term, the negotiation term is automatically extended”.(Column 8, lines 40-52). It would have been obvious to one having ordinary skill in the art at the time the invention was made to

combine the Sloo ('450) method with the Burchetta et al. ('551) method in order in order to improve the percentage of negations that are settled.

As per claim 11,

Sloo ('450) discloses a method according to claim 10 Sloo ('450) does not explicitly disclose "when there is no response information or the number of response information does not reach a predetermined threshold value upon expiration of the negotiation term, the negotiation term is automatically extended", Burchetta et al. ('551) discloses "when there is no response information or the number of response information does not reach a predetermined threshold value upon expiration of the negotiation term, the negotiation term is automatically extended".(Column 8, lines 40-52). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Burchetta et al. ('551) method in order in order to improve the percentage of negations that are settled.

### **Response to Arguments**

The Applicants arguments filed on June 7,2007have been fully considered.

The Examiner states that the amended feature of "purchase information" is insufficient to distinguish the claimed invention from the cited prior art, Sloo states that the complainant might establish a "monetary value " (generally disclosed around column 7) that would be part of a settlement agreement. The Examiner contendt that this feature is analogous to the claimed feature of "forming requesting conditions including a plurality of conditional items in which

priorities have been allocated to request purchase information in response to a mediating request of said client received via the network.”

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Winter whose telephone number is (571) 272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John Winter  
Patent Examiner -- 3621



ANDREW J. FISCHER 12/10/07  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600